



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

On Re Patent Application of)	Confirmation No.: 2842
Lawrence F. GLASER)	
Application No. 09/270,710)	Examiner: Kalinowski, Alexander G
Filed: March 16, 1999)	Art Unit: 3626
For: METHOD OF EMBEDDING)	
ADVERTISEMENT IN)	September 1, 2005
COMMUNICATION)	

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
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Deborah Novahhedi
Deborah Novahhedi

Sir:

In accordance with the provisions of 35 U.S.C. §134 and 37 C.F.R. §41.37, Appellant submits this Appeal Brief in support of the Notice of Appeal filed July 1, 2005 and to appeal the Examiner's final rejections in the Final Office Action of April 1, 2005.

I. REAL PARTY IN INTEREST

Lawrence F. Glaser is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellant, the Appellant's representative, or the assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

For the purposes of this Appeal, claims 1-26 have been rejected. Thus, this Appeal is taken from the rejection of claims 1-26 as submitted in the Appendix herewith.

IV. STATUS OF AMENDMENTS

No amendments have been made to the claims subsequent to the final rejections stated in the Final Office Action of April 1, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This Appeal is taken from claims 1-26, of which claims 1, 20 and 24 are independent.

With respect to claim 1, the present invention recited therein relates to a method of sending an advertisement from one party to another party. The method includes initiating a communication (e.g., e-mail, voice mail, fax, etc.) from a data processing system (e.g., PC) of a sending party, associating a pre-selected advertisement with the communication within the data processing system (e.g., PC) of the sending party, and transmitting the communication with the pre-selected advertisement embedded therein to a receiving party. Support for the claimed features can be found at least on, e.g., page 4, lines 16-26, page 5, lines 1-10, page 6, lines 15-27, and page 9, line 22 to page 10, line 2 of the specification.

With respect to independent claim 20, the invention recited therein relates to a method of transmitting an electronic communication (e.g., e-mail, voice mail, fax, etc.) with an advertisement from one party to another party. The method includes locating a data file containing signature information on the data processing system (e.g., PC) of the sending party, wherein the signature information being appended to electronic communications originating from the sender's data processing system, modifying the information stored within the signature data file to include an embedded advertisement, and transmitting the electronic communication using the sending party's data processing system to the data processing system associated with the receiving party. In addition to the support for claim 1 discussed above, support for the features of claim 20 also can be found at least in, e.g., Fig. 1, Fig. 3, page 11, lines 1-22, and page 20, lines 17-25 of the specification.

With respect to independent claim 24, the invention recited therein relates to sending an advertisement from one party to another party. The differences between independent claim 1 and independent claim 24 is that claim 24 specifies that the pre-selected advertisement is under the local control of the sending party. Support for this feature can be found at least on page 4, lines 21-23, page 5, lines 11-20, Fig. 1 and its associated description beginning on page 10, line 19 to page 11, line 22, page 13, line 13 to page 15, line 15 and Fig. 2, for example.

The presently claimed invention addresses the effectiveness issue of known methods of advertisement, such as internet banners, unsolicited commercial e-mail, etc. (as described in page 1, second paragraph to page 4, first paragraph of the present application) and provides a method for a party sending a telecommunication message to include an advertisement in the message and sending the same to a recipient so as to effect a point-to-point advertisement method.

According to the presently claimed invention, the sending party can include a personal endorsement in an e-mail, for example, for a product or service used by the sending party. The product could be a software or hardware installed and operated on a local computer system used and managed by the sending party, and the inclusion of the product advertisement with the email resulted from an election made by the sending party during the installation of the software/hardware module, which can only occur if the data processing system is local and under the control of a user of the data processing system, i.e. a sending party.

The presently claimed invention utilizes a data processing system associated with the sending party. That is, the sending party has control over the data processing system and of the software or hardware that is installed on the processing system. An example of a user-managed data processing system is PC used at home or a workstation at the office that can be connected to a receiving party's computer system via a telephone modem, DSL/cable modem, satellite dish, LAN, etc.

An embodiment discussed in page 13, line 13 through page 15, line 15, and Fig. 2 clearly shows that the data processing system associated with the user is data processing system under the local control of the sending party. This data processing system is user-controlled, in addition to being local to the user or sending party, so that he/she can install a peripheral device him or herself, and has full control over whether or not to add advertisement relating to the peripheral in his/her email messages.

The sender manages the data processing system, as well as the advertisement option, in the presently claimed invention. Using the presently claimed invention, the sending party is empowered with the choice relating to the type of advertisement as well as the intended recipients so that a grass-root effect can be achieved and so that spamming can be avoided.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The ground of rejection to be reviewed on appeal is the rejection of claims 1-19 and 23-26 under 35 U.S.C. §103(a) as being unpatentable over WO 96/24213A (Goldschmitt et al. – hereafter Goldschmitt) in view of Bezos et al. (U.S. Patent No. 6,029,141 – hereafter Bezos), and the rejection of claims 20-21 under 35 U.S.C. §103(a) as being unpatentable over Goldschmitt in view of Bezos and Uomini (U.S. Patent No. 6,018,761 – hereafter Uomini).

VII. ARGUMENTS

Regarding the §103(a) rejection of independent claim 1 over Goldschmitt and Bezos:

Appellant respectfully asserts that the Examiner has failed to set forth a *prima facie* case of obviousness, since Goldschmitt fails to teach, disclose or suggest at least the step of embedding the advertisement within the communication or associating at least one pre-selected advertisement with the communication within the data system of the sending party, as recited in claim 1, and since Bezos fails to teach, disclose or suggest the step of embedding the advertisement within the communication or associating the pre-selected advertisement with said communication within the data processing of the sending party, as recited in claim 1. Further, as Goldschmitt and Bezos are deficient as noted above, and as there is no suggestion or motivation to combine their respective teachings, their combination in the §103(a) rejection is improper. Even if Bezos and Goldschmitt were combined, their combination does not teach or suggest all of the features of claim 1.

The Supreme Court, in *Graham v. John Deere*, set forth the basic test for patentability under 35 U.S.C. §103.¹

¹ See *Graham v. John Deere*, 383 U.S. 1 at 18, 148 USPQ 459 at 167 (1996)

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved need, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter to be patented.

Moreover, in *In re Ehrreich and Avery*, the Court of Customs and Patent Appeals further clarified the basic test set forth in *Graham v. John Deere*.²

We must not here consider a reference in a vacuum, but against the background of the other references of record which may disprove theories and speculations in the reference or reveal previously undiscovered or unappreciated problems. The question in a §103 case is what the references would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972). It is only by proceeding in this manner that we may fairly determine the scope and content of the prior art according to the mandate of *Graham v. John Deere*, 383 US 1, 17, 148 USPQ 459, 467 (1966)(Emphasis in original.)

It should be noted that three criteria must be met to establish a *prima facie* case of obviousness.³ First, there must be some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.⁴ Second, there must be a reasonable expectation of success.⁵ Last, the prior art must teach or suggest all the claim limitations.⁶

Initially, in the Final Office Action mailed April 1, 2005, the Examiner stated on page 3:

“Goldschmitt does not explicitly disclose embedding the advertisement within the communication. associating the preselected advertisement with said communication within the user-managed data processing system.”

However, Appellant notes that the present language of claim 1 actually reads as follows:

² See *In re Ehrreich and Avery*, 200 USPQ 504, 509-510 (CCPA 1979)

³ See *M.P.E.P.* §2143

⁴ See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

⁵ See *In re Rhinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976)

⁶ See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

“... associating at least one pre-selected advertisement with said communication within the data processing system of the sending party; and transmitting said communication with said at least one advertisement embedded therein to the recipient.”

Hence, the Examiner recycled his rejections from a previous Office Action while ignoring the pending claimed features. Appellant therefore submits that the final Office Action of April 1, 2005 is improper. Notwithstanding the Examiner's consistent recycling of old rejections, as will be shown in additional examples herein, Appellant respectfully responds to the rejection herein based on the presently claimed features of claim 1.

In the rejection of claim 1 of the Office Action mailed April 1, 2005, the Examiner asserted that Bezos discloses embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system. The Examiner cited col. 1, lines 56-61 and col. 8, lines 59 – col. 9, lines 50-55 of Bezos as support and alleged that Bezos cures the deficiency of Goldschmitt. However, prior to responding to the Examiner's allegation, and in order to better understand the Examiner's interpretation of Bezos, Appellant will now discuss the Examiner's previous Office Actions that Appellant deems essential to shed light on the Examiner's final rejections in the Office Action of April 1, 2005.

For example, in the Office Action of September 9, 2004, the Examiner states that “Bezos discloses embedding the advertisement within the communication and associating the pre-selected advertisement with said communication within the user-managed data processing system (i.e. can disseminate catalogs... e-mail newsletters... that include the associate's reviews and/or recommendations on specific products sold by the merchant)”. In another example, in the interview of December 29, 2004, the Examiner clarified his position in contending that the “associate” of Bezos is equivalent to the sending party, and the “customer” of Bezos is equivalent to the recipient of Appellant's presently claimed invention. Also, the Examiner stated in the interview that the graphic icon hyperlink 600 in Fig. 6 of the Bezos reference is the advertisement, and that the “catalog” 120 includes a communication message 606 in Fig. 6 of Bezos. Hence, according to the Examiner, Fig. 6 of Bezos, in combination with the teaching of Goldschmitt, teaches, discloses or suggests Appellant's claim 1, which previously included claimed steps of:

initiating a communication from a data processing system of a sending party;

associating at least one pre-selected advertisement with said communication within the data processing system of the sending party; and

transmitting said communication with said at least one advertisement embedded therein to the recipient,

wherein said at least one advertisement optionally includes a hyperlink.

Returning now to the rejection of claim 1 in the Final Office Action of April 1, 2005, Appellant respectfully asserts that the Examiner-cited text of Bezos discloses a software system and method for enabling an Internet sales merchant, to market and sell goods in cooperation with Web sites or other networks sites of respective business partners, referred to as “associates.” The merchant can enroll as an associate, and can disseminate catalogs (web documents, PUSH documents, e-mail newsletters, etc.) that include the associate’s reviews and/or recommendations on specific products sold by the merchant. The associate catalog documents referred to by the Examiner is the catalog document 120 (i.e., HTML documents or web pages in Fig. 6) include product-specific hyperlinks (i.e., referral links 600 or 608), and a statement 606 directly related to the product referred to in the referral hyperlink. Appellant respectfully asserts that the disseminated catalogs (i.e., HTML web pages selling products) of Bezos do not have advertisements embedded therein as required by the pending claims, and that the catalog document 120 with referral hyperlink 600 or 608 is unlike Appellant’s communication and pre-selected advertisement.

In other words, contrary to the Examiner’s understanding, Bezos does not teach the association of advertisements in a communication and transmitting the communicating with the embedded advertisement to a recipient. Instead, as disclosed by Bezos, an “associate” web site provides a hypertextual “referral link” that allows a customer visiting the associate’s web site to link to the merchant’s web site by clicking on a “referral link” to initiate purchases of products from the merchant, which subsequently allows the merchant to identify the product and its referring associate.

In Bezos, the referral hyperlink (600 or 608) displayed in an HTML catalog document 120, as shown in Fig. 6 of Bezos, is an essential component in a software system and method for enabling an Internet sales merchant (e.g., Amazon.com), to market and sell goods to

“customers” in cooperation with Web sites or other network sites of respective business partners, referred to as “associates.” The referral hyperlink of Bezos includes a unique product ID, the unique store ID associated with a particular associate, and an optional associate commission ID from the URL data string represented by the referral hyperlink.

Further, the invention of Bezos, as interpreted by the Examiner, requires an interaction between the “customer,” the “associate” and the “merchant,” and the essential feature which enables the business paradigm to work is the referral hyperlink. That is, without the referral hyperlink or the existence of the “merchant”, the system or process of Bezos would not work. In combining Bezos with Goldschmitt, the Examiner essentially ignored the criticality of the function of the “merchant” and of the real function of the referral hyperlink of Bezos. In other words, the Examiner failed to consider that the critical “merchant” taught in Bezos has no similar limitation or equivalent function in Appellant’s claimed invention or in that of Goldschmitt, and that the Examiner failed to consider the teaching of Bezos in its entirety in establishing a *prima facie* case of obviousness (See MPEP 2141.02 p. 2100-122 Rev. 1, Feb. 2003).

Unlike the catalog document 120 of Bezos which must include the referral hyperlink 600 or 608, Appellant’s invention, as recited in claim 1, does not require a hyperlink. Appellant will discuss this important point below.

According to the Interview Summary dated March 30, 2004, the Examiner acknowledged and agreed with Appellant that the advertisement in Bezos is a hyperlinked document itself, whereas the embedded advertisement in the presently claimed invention can but need not include a hyperlink, which is not itself the embedded advertisement. Accordingly, Appellant’s understood such admission and the discussion during the interview meant that if a clear distinction between a hyperlink and an embedded advertisement is made, the application would be passed to allowance. Hence, to advance the application toward allowance, Appellant amended claim 1, as well as independent claim 20, in the Amendment filed May 26, 2004 to provide distinction between an advertisement and a hyperlink and thereby overcome Bezos. That is, Appellant amended claims 1 and 20 by further reciting the clause “wherein said at least one advertisement optionally include a hyperlink”, as there is no such distinction between a hyperlink and an advertisement disclosed or suggested by Bezos.

Subsequent to the Amendment filed May 26, 2004 wherein the distinction between a hyperlink and an advertisement was made by claim amendments, the Examiner changed is

interpretation and asserted in the Office Action mailed September 9, 2004 that there is no distinction between a referral hyperlink and an advertisement in Bezos, hence the referral hyperlink of Bezos is allegedly equivalent to Appellant's claimed embedded advertisement.

The Examiner further stated that even the hyperlink displaying the product (i.e., Fig. 6, unit 600) is a form of advertisement that is under the control of the associate, that the associate's reviews, editorial description, and recommendations all constitute a form of advertisement. That is, the Examiner broadly concluded that anything that can be seen or heard is a form of advertisement. Hence, the referral hyperlink 600 or 608 of Fig. 6 of Bezos is still interpreted as an embedded advertisement by the Examiner and that the distinction between a hyperlink and an embedded advertisement made in the Amendment filed May 26, 2004 did not overcome Bezos. Note that the aforementioned assertion made by the Examiner is inconsistent with the Examiner's statement made in the Interview of December 29, 2004, wherein the Examiner clarified that the graphic icon hyperlink 600 in Fig. 6 of the Bezos reference is the advertisement, and that the "catalog" 120 includes a communication message 606 in Fig. 6 of Bezos.

In response to the Examiner's assertion that "anything that can be seen or heard is a form of advertisement", Appellant again amended claims 1 and 20 in the Amendment filed January 10, 2005 and the Request for Continuing Examination March 10, 2005 to effect entry of the Amendment filed January 10, 2005. The Amendment filed January 10, 2005 was to delete the language "wherein said at least one advertisement optionally includes a hyperlink" in independent claims 1 and 20, and to add new dependent claims 25 and 26, which depend from claims 1 and 20, respectively, to recited this feature and to thereby invoke the doctrine of claim differentiation. In re *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed. Circ. 1999), In re *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.* (381 F.3d 1111; 2004 U.S. App.).

Appellant respectfully submits that the amendment to claims 1 and 20 in the Amendment filed May 26, 2004 to add the clause "wherein said at least one advertisement optionally includes a hyperlink" clearly distinguish an embedded advertisement from a hyperlink. Further, the distinction between a hyperlink and an advertisement was made stronger by invoking the doctrine of claim differentiation in the amendment to claims 1 and 20 in the Amendment filed January 10, 2005 (which later was entered by filing an RCE) as discussed above.

The doctrine of claim differentiation means that limitations stated in dependent claims are not to be read into the independent claims from which they depend (*In re Karlin Tech*, supra). This interpretative tool stems from the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope. Dependent claims 25 and 26 clearly differentiate from the meaning and scope of independent claims 1 and 20, respectively. In other words, by separating the feature wherein the at least one advertisement includes a hyperlink, Appellant has clearly distinguished a hyperlink from an embedded advertisement. That is, in Appellant's claimed invention, referral hyperlinks are not themselves an advertisement, which is inherently different from the Examiner's interpretation of the referral hyperlink of Bezos.

Again, in contrast with Appellant's claimed feature, the Examiner interprets the referral hyperlink of Bezos as a form of advertisement. The Examiner also interprets the Associate's reviews, recommendations, etc., as an advertisement. Hence, there is no differentiation between hyperlink and an advertisement, according to the Examiner. Incidentally, as the Examiner stated that everything can be an advertisement, including hyperlinks and Associate's reviews and comments recommending a product, the Examiner left no explanation for what in Bezos is equivalent to Appellant's claimed communication and what is an advertisement embedded in the communication.

As set forth above, Bezos' internet-based customer referral system is clearly different from the method of transmitting a communication including an advertisement of the presently claimed invention. Further, Bezos' internet-based customer referral system is clearly different from the method of providing free e-mail messaging to end-users of Goldschmitt.

In view of the above-presented summary and arguments, Appellant respectfully asserts that Bezos does not teach, disclose or suggest Appellant's claimed features of associating at least one pre-selected advertisement with said communication within the data processing system of the sending party, and transmitting said communication with said at least one advertisement embedded therein to the recipient, as presently recited in claim 1. Appellant respectfully asserts that Bezos in combination with Goldschmitt still fails to teach, disclose or suggest all the claimed limitations, and that there is no motivation to combine Bezos' teaching with that of Goldschmitt to arrive at Appellant's invention as recited in claim 1.

Regarding the §103(a) rejection of independent claim 24 over Goldschmitt and Bezos:

The difference between independent claim 1 and independent claim 24 is that claim 24 further recites “wherein the pre-selected advertisement is under the control of the sending party. Hence, Appellant’s arguments set forth above with respect to claim 1 are also applicable to the rejection of claim 24.

The Examiner asserted that Bezos teaches that the pre-selected advertisement is under the control of the sending party and hence, cures this deficiency of Goldschmitt. In response, Appellant would like to traverse the rejection for the reasons provide below.

Prior to discussing the invention of claim 24, Appellant would like to summarize the disclosed invention of Goldschmitt. Goldschmitt’s invention relates to a method for providing free email messaging to end-users, wherein the free email messaging is supported by sponsors who advertise their products and services by appending an advertisement to an email message after a special delimitator. In the operation of an aspect of Goldschmitt’s invention, an email message sent by a sender is received and stored at a remote mail server associated with advertisement sponsors. Upon request by an addressee to download a message, an advertisement is selected and appended to the email message after a special delimitator, then the email and the appended advertisement is sent to the addressee (see page 3, lines 18-28 of Goldschmitt).

The method of delivery of an advertisement in the system for providing free email service of Goldschmitt is specifically designed for providing, among other things, a specific advertisement at a specific targeted time of the day. Therefore, an advertisement is appended to an incoming email as the email is downloaded by the addressee from the email server (see page 4, line 26 to page 5, line 19 of Goldschmitt). Moreover, in Goldschmitt, the appending of an advertisement to an email is performed at a remote mail server associated with the sponsors.

In contrast with Goldschmitt, claim 24 of the present invention recites, among other features, the pre-selected advertisement is under the control of the sending party. As presented above, the present invention addresses the effectiveness issue of known methods of advertisement, such as internet banners, unsolicited commercial e-mail, etc. and provides a method for a party sending a telecommunication message to include an advertisement in the message and send the same to a recipient so as to effect a point-to-point advertisement method. According to claim 24, the email includes an embedded advertisement for a product or service

used by the sending party. The product could be a software or hardware installed and operated on a local computer system used and managed by the sending party, and the inclusion of the product advertisement with the email resulted from an election made by the sending party during the installation of the software/hardware module, which can only occur if the data processing system is local and managed by a user, i.e. a sending party.

To accomplish the above-discussed objectives, the presently claimed invention utilizes a data processing system associated with the sending party. More specifically, the data processing system is local to the sending party. That is, the sending party has control over the data processing system and of the software or hardware that is installed on the processing system. An example of a data processing system under the local control of the sending party is a PC used at home or a workstation at the office that can be connected to a remote computer system via a telephone modem, DSL/cable modem, satellite dish, LAN, etc.

An embodiment discussed in page 13, line 13 through page 15, line 15, and Fig. 2 clearly shows that the data processing system associated with the user is a locally controlled data processing system. This data processing system is user-managed, in addition to being local to and of the sending party, so that he/she can install a peripheral device him or herself, and has full control over whether or not to add advertisements relating to the peripheral in his/her email messages. On the other hand, in the invention of Goldschmitt, subscribers of free email are provided with no choice but to have email advertisement appended to their messages. Further, subscribers of free email messaging have no control over the products, or services that are advertised by the sponsors. As such, spamming would be considered as an effect of utilizing Goldschmitt's invention.

Further, the center 20 and email server 18 of Goldschmitt are not managed by or under the local control of the user or email sender. That is, the sending party does not have control or management of Goldschmitt center 20 and email server 18 to perform the steps recited in Appellant's pending claims. As disclosed in Fig. 1, page 8, line 26 - page 9, line 2, Goldschmitt teaches that a message sent by user 12 to user 20 and is stored at center 18 until user 20 accesses it. When user 20 commands to read the message, the center 18 then appends an advertisement, if any, to the message and transmits the message to user 20.

Appellant respectfully submits that, in addition to being deficient in disclosing or suggesting initiating a communication from a data processing system of the sending party,

Goldschmitt teaches away from the concept wherein the pre-selected advertisement is under the local control of the sending party, as set forth in independent claim 24. As Goldschmitt teaches away from the concept of pre-selecting advertisement being under the control of the sending party, combining Goldschmitt with Bezos, which allegedly teaches pre-selecting advertisement being under the control of the sending party, is improper.

With respect to Bezos, the Examiner asserted that “Bezos disclose the pre-selected advertisement is under the local control of the sending party (i.e., unit 120)(see Fig. 1 and col. 6, lines 59-67)” and that “It would have been obvious to one of ordinary skill in the art at the time of Appellant’s invention to include the aforementioned limitation as disclosed in Bezos within Goldschmitt for the motivation stated above for claim 1.” In response to the Examiner’s assertion, Appellant notes again that the limitation 120 of Bezos represents a product catalog document, i.e. HTML document or web page, with link to a URL, as shown in Figs. 1 and 6 and col. 11, 43-62, for example. The product catalog document 120, as shown in Fig. 6, contains a testimonial 606 of a product or service referred to in hyperlink 600 or 608, which direct a viewer of the document to a merchant web site where the product or service could be purchased.

As discussed above, the referral link of Bezos includes a unique product ID, the unique store ID associated with a particular associate, and an optional associate commission ID from the URL data string represented by the referral hyperlink. Without the referral hyperlink in the product catalog document 120, the disclosed method that enables internet commerce in Bezos would not work.

As discussed above, the Examiner continually asserted that the referral hyperlink of Bezos is the embedded advertisement. However, Appellant notes that claim 24 of the present application does not require a hyperlink. In other words, Appellant’s claimed embedded pre-selected advertisement does not require a hyperlink and in itself is not a hyperlink, and Appellant has made a clear and unmistakable distinction between a hyperlink and an advertisement in the prosecution history of claims 1 and 24, as discussed above. Therefore, Bezos does not teach, disclose, or suggest Appellant’s pre-selected advertisement and associating the pre-selected advertisement is under the local control of the sending party, as recited in claim 24. Accordingly, Appellant respectfully submits that the combination of Goldschmitt and Bezos in the rejection of claim 24 is improper and a *prima facie* case of obviousness has not been established.

Regarding the §103(a) rejection of independent claim 20 over Goldschmitt, Bezos and Uomini:

In the rejection of claim 20, the Examiner asserted “Goldschmitt does not explicitly disclose embedded the advertisement within the communication”, “associating the preselected advertisement with said communication within the user-managed data processing system wherein said at least one advertisement optionally includes a hyperlink”.

As a side note, Appellant respectfully submits that the Examiner recycled the same rejection made on page 3 of the Office Action mailed September 9, 2004, and that the Examiner ignored the amendment to claim 20 submitted in the Amendment filed January 10, 2005, which subsequently was entered by filing a RCE, as noted above. Moreover, the Examiner rejected features that are not recited in claim 20. Hence, in responding to this rejection, Appellant will focus on the claimed features of currently pending claim 20.

To cure the above-mentioned deficiency of Goldschmitt, the Examiner cited Bezos. However, notwithstanding the fact that the Examiner rejected unclaimed features, Appellant notes that these features have been discussed, as set forth above in relation to the rejection of claims 1 and 24 over Goldschmitt and Bezos.

In the rejection of claim 20, the Examiner then admitted that both “Goldschmitt and Bezos do not explicitly disclose the step of locating a data file containing signature information on the data processing system associated with the sending party, said the signature information being appended to electronic communications originating from the user managed data processing system associated with the sending party; modifying information stored within said signature file to include an advertisement; and said electronic communication including said information stored within said signature file including said advertisement.” To cure the deficiencies of Goldschmitt and Bezos, the Examiner applied Uomini and contended that Uomini discloses the signature block which may contain business information (i.e. advertisement) (col. 5, lines 10-12). That is, the Examiner asserted that the vCard attached to an e-mail message as disclosed in Uomini encompasses Appellant’s claimed step of modifying the information stored within the signature file to include an advertisement. In response, Appellant respectfully asserts that the

combination of Uomini with Goldschmitt and Bezos is further improper at least for the reasons provided below.

In response to the Examiner's rejection, Appellant respectfully directs the Board to the first paragraph of page 14 of Goldschmitt. It is specifically disclosed therein that advertisement attached to an electronic mail without interfering with the integrity of the message data contained within the electronic mail. Therefore, it would be contrary to the teaching of the primary reference to Goldschmitt to modify the information stored within the signature file to include at least one advertisement, as recited in Appellant's claim 20.

The Examiner asserted during the Interview of December 29, 2004 that the vCard being attached to an e-mail message as disclosed in Uomini encompasses Appellant's claimed step of modifying the information stored within the signature file to include an advertisement. However, Uomini merely discloses a system for adding to an electronic mail message context information regardless of whether or not the sender includes context information. Context information is information such as full name, address, telephone number, etc. The context information assists the receiver of electronic mail messages in identifying sender and/or where the electronic mail has originated.

Appellant respectfully submits that Uomini does not teach, disclose or suggest embedded advertisement, and that Uomini does not suggest or motivate modifying the information stored in the signature file to include an advertisement as recited in claim 20. Further, as the Examiner interprets the vCard as an advertisement attached to an electronic mail message, and as the Examiner stated that anything that can be seen or heard is a form of advertisement, the Examiner is improperly stretching the meaning of embedded advertisement beyond the scope of this instant invention as well as beyond the scope of the cited prior art references.

According to col. 2, lines 34-44 of Uomini, a vCard can be attached to an e-mail message, or can be used outside of a mail system, to present a user's "business card" data in a standardized format. "Business card" data is that data which normally appears on a business card, such as name address, telephone number, alternate number, e-mail address, picture, etc., as well as other identifying information which might be added to a business card when it becomes an electronic business card, such as a video or audio clip. Appellant respectfully submits that Uomini does not teach, disclose or suggest Appellant's claimed step of modifying the


information stored within a signature file to include at least one advertisement, and that the vCard is not a signature file.

The vCard disclosed in Uomini is an electronic business card having a standard established by a consortium, and vCard is attached to an e-mail message or used outside of an e-mail system, as noted by Uomini. Appellant respectfully asserts that vCards cannot be and are not to be inserted or embedded into an e-mail signature file.

It is well settled that when combining the references in order to support a *prima facie* case of obviousness, the references must be considered in their entirety. It is further settled that the mere fact that the prior art may be modified to reflect features of the claimed invention does not make the modification and hence the claimed invention obvious unless the desirability of such modification is suggested by the prior art itself (MPEP §2141). As Goldschmitt clearly teaches that the integrity of an electronic mail cannot be compromised, and as Uomini does not teach, disclose or suggest modifying the information stored in the signature file to include an embedded advertisement, the combination of Goldschmitt, Bezos and Uomini is improper. Further, the Examiner's assertion that it would be obvious to combine Goldschmitt with Bezos and Uomini clearly ignore the requirement that the references must be considered in their entirety.

Accordingly, for at least the reasons outlined above, Appellant respectfully submits that a *prima facie* case of obviousness has not been established in the rejection of the pending claims.

Respectfully submitted,
NIXON PEABODY, LLP



Donald R. Studebaker
Registration No. 32,815

NIXON PEABODY LLP
401 9th Street, N.W., Suite 900
Washington, DC 20004
(202) 585-5000
(202) 585-8080 (Fax)

VIII. CLAIMS APPENDIX

1. (Previously Presented) A method of transmitting an advertisement from a sending party to a receiving party comprising the steps of:
initiating a communication from a data processing system of a sending party;
associating at least one pre-selected advertisement with said communication within the data processing system of the sending party; and
transmitting said communication with said at least one advertisement embedded therein to the recipient.
2. (Previously Presented) The method of claim 1, further comprising the steps of:
offering to a user an option of becoming an advertiser; and
enabling, if the offer is accepted, a procedure within said data processing system by which the at least one advertisement is associated with the communication.
3. (Previously Presented) The method of claim 1, wherein the at least one advertisement is related to at least one of software or hardware operable with the data processing system.
4. (Original) The method of claim 1, wherein the communication is at least one of e-mail, facsimile, voice-over-IP, voice-over-Internet, voice mail, video mail, video teleconferencing, and an animated presentation.
5. (Previously Presented) The method of claim 1, wherein the at least one advertisement is sent for a pre-selected time period.
6. (Previously Presented) The method of claim 1, wherein the at least one advertisement is sent up to a pre-selected number of times.

7. (Previously Presented) The method of claim 1, wherein the at least one advertisement is electronically obtained from a third party data processing system.

8. (Original) The method of claim 2, wherein the user is compensated for accepting the offer to become an advertiser.

9. (Previously Presented) The method of claim 1, wherein the at least one advertisement is at least one of visual and aural.

10. (Previously Presented) The method of claim 2, wherein the at least one advertisement is incorporated in setup software for one of software and hardware.

11. (Original) The method of claim 2, wherein means for sending the communication comprises at least one of an e-mail client, a facsimile system, a voice-over-IP system, a voice-over-Internet system, a voice mail system, a video mail client, and a video teleconferencing system.

12. (Original) The method of claim 2, further comprising offering to a recipient of the communication and advertisement an option of being an advertiser.

13. (Original) The method of claim 12, wherein said step of offering to a recipient of the communication and advertisement an option of being an advertiser includes fraud avoidance means for reducing or eliminating fraud associated with the transaction.

14. (Previously Presented) The method of claim 7, wherein said at least one advertisement is electronically obtained from a third party data processing system using the Internet.

15. (Previously Presented) The method of claim 1, wherein the at least one advertisement is displayed to a recipient during a period of at least one of before, during and after the communication.

16. (Previously Presented) The method of claim 1, wherein the data processing system is at least one of a computer and telephone.

17. (Previously Presented) The method of claim 2, wherein the at least one advertisement is embedded in the communication by a third party.

18. (Previously Presented) The method of claim 1, wherein said at least one advertisement is determined at least in part by the recipient's demographic.

19. (Previously Presented) The method of claim 18, wherein said demographic is at least one of location, language, gender, age, income, and physical handicap.

20. (Previously Presented) A method of transmitting an electronic communication including at least one advertisement from a data processing system of a sending party to a data processing system of a receiving party comprising the steps of:

locating a data file containing signature information on the data processing system of the sending party, said signature information being appended to electronic communications originating from the sender's data processing system;

modifying the information stored within said signature file to include at least one advertisement; and

transmitting an electronic communication using the sender's data processing system to the data processing system associated with the recipient, said electronic communication including said information stored within said signature file including said at least one advertisement.

21. (Previously Presented) The method of claim 20, wherein said signature file is associated with an e-mail Client operating on said data processing system of the sending party.

22. (Previously Presented) The method of claim 1, wherein associating said at least one pre-selected advertisement with said communication further comprises associating a

personal testimonial by said sending party thereby lending credibility to said at least one advertisement.

23. (Previously Presented) The method of claim 1, wherein the pre-selected advertisement is under the local control of the sending party.

24. (Previously Presented) A method of transmitting an advertisement from a sending party to a receiving party comprising the steps of:

initiating a communication from a data processing system of a sending party;

associating at least one pre-selected advertisement with said communication within the data processing system of the sending party, wherein the pre-selected advertisement is under the local control of the sending party; and

transmitting said communication with said at least one advertisement embedded therein to the recipient.

25. (Previously Presented) A method of transmitting an advertisement from a sending party to a receiving party of claim 1, wherein said at least one advertisement includes a hyperlink.

26. (Previously Presented) A method of transmitting an electronic communication including at least one advertisement from a data processing system of a sending party to a data processing system of a receiving of claim 20, wherein said at least one advertisement includes a hyperlink.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to this Appeal.



Handwritten signature/initials

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/270,710
		Filing Date	March 16, 1999
		First Named Inventor	Lawrence F. GLASER
		Group Art Unit	3626
		Examiner Name	Alexander G. Kalinowski
Total Number of Pages in This Submission	2	Attorney Docket Number	740388-20

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> One Month Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (APPEAL BRIEF - In TRIPLICATE) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Application Data Sheet <input type="checkbox"/> Request for Corrected Filing Receipt with Enclosures <input type="checkbox"/> A self-addressed prepaid postcard for acknowledging receipt <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 19-2380 for the above identified docket number.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Donald R. Studebaker, Reg. No. 32,815 Nixon Peabody LLP 401 9 th Street, N.W. Suite 900 Washington, D.C. 20004-2128
Signature	<i>Handwritten signature of Donald R. Studebaker</i>
Date	September 1, 2005

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9-1-05 Date	<i>Deborah Morahkedi</i> Signature <u>Deborah Morahkedi</u> Typed or printed name

FEE TRANSMITTAL FOR FY 2004

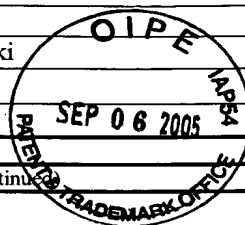
Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$250.00)

Complete if Known

Application Number 09/270,710
Filing Date March 16, 1999
First Named Inventor Lawrence F. GLASER
Examiner Name Alexander G. Kalinowski
Art Unit 3626
Attorney Docket No. 740388-20



METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 19-2380 [740388-20]

Deposit Account Name Nixon Peabody LLP

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ 0)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
	-20** =	X	
Independent Claims	-3** =	X	
Multiple Dependent		X	

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description
1051	130	2051	65	Surcharge - late filing fee or oath
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet
1053	130	1053	130	Non-English specification
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action
1251	120	2251	60	Extension for reply within first month
1252	420	2252	210	Extension for reply within second month
1253	950	2253	475	Extension for reply within third month
1254	1,480	2254	740	Extension for reply within fourth month
1255	2,010	2255	1,005	Extension for reply within fifth month
1401	500	2401	250	Notice of Appeal
1402	330	2402	165	Filing a brief in support of an appeal
1403	290	2403	145	Request for oral hearing
1451	1,510	1451	1,510	Petition to institute a public use proceeding
1452	110	2452	55	Petition to revive - unavoidable
1453	1,330	2453	665	Petition to revive - unintentional
1501	1,330	2501	665	Utility issue fee (or reissue)
1502	480	2502	240	Design issue fee
1503	640	2503	320	Plant issue fee
1460	130	1460	130	Petitions to the Commissioner
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)
1806	180	1806	180	Submission of Information Disclosure Stmt
8021	40	8021	40	Recording each patent assignment per property (times number of properties)
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))
1801	770	2801	385	Request for Continued Examination (RCE)
1802	900	1802	900	Request for expedited examination of a design application

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$250.00)

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Name (Print/Type) Donald R. Studebaker

Registration No. 32,815
(Attorney/Agent)

Complete (if applicable)

Telephone (202) 585-8000

Signature

Donald R. Studebaker

Date

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